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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/589,140

09/26/2006

Friedrich Haberle

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OSTROLENK FABER GERB & SOFFEN  
1180 AVENUE OF THE AMERICAS  
NEW YORK, NY 100368403

EXAMINER

HOWELL, DANIEL W

ART UNIT

PAPER NUMBER

3726

MAIL DATE

DELIVERY MODE

09/02/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/589,140	<b>Applicant(s)</b> HABERLE ET AL.	
	<b>Examiner</b> Daniel W. Howell	<b>Art Unit</b> 3726	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 17-20 is/are rejected.
- 7) ☒ Claim(s) 11-16 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>5-10-07, 8-10-06</u> . | 6) <input type="checkbox"/> Other: ____.  |

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1. New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because the line quality of the present drawings is poor. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

2. Claim 10 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 10 should depend from claim 9 in order to provide proper antecedent basis for the clamping surface.

3. Claim 9 is objected to because of the following informalities: in line 4 of claim 9, it appears that "in the claw" should actually be "by the claw." Appropriate correction is required.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the

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reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claims 1 and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Inoue (6783449). Figure 1 shows a tool having a first machining step 30 with four cutting edges and a second honing step with a series of honing strips separated by slits 13a. Threads 32a are considered to be a precision interface.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 6 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Inoue '449 in view of Nagel et al (5088237). The honing strips of Inoue are not adjustable. Figure 1 and column 2, lines 34-40, of Nagel et al shows five slots 20 having honing strips 21 therein, and a wedge 15 for setting the diameter of the strips 21. It is considered to have been obvious to have equipped Inoue with the individual replaceable strips as shown by Nagel in order to permit the diameter of the strips to be adjusted.

8. Claims 2-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Inoue '449 in view of Takagi (6238151). Inoue gives few details of the reaming cutter. Figures 6 and 7 and column 8, lines 1-23, discuss providing the cutting edge on a removable insert/knife plate 10 and providing the insert with a circular chamfer 14A having the same diameter as the hole being machined, such that the chamfer will guide and center the tool in the hole. It is considered to have been obvious to have provided the cutting edges of Inoue with such conventional circular

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chamfers as shown by Takagi in order to center and guide the tool within the hole. It is also considered to have been obvious to have placed the cutting edges of Inoue on removable knife plate as shown by Takagi such that the cutting edge may be replaced when it is worn out.

9. Claims 4-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Inoue '449 in view of Planche (5906458). Figures 1-2 of Planche show a reamer having a removable cutting edge 14 that fits in a slot having sides 15, 17, and a bottom, and guide pads 24, 25. It is considered to have been obvious to have provided Inoue with one or more guide pads as shown by Planche to aid in centering the tool within the hole during machining. It is also considered to have been obvious to have placed the cutting edges of Inoue on removable knife plate/insert as shown by Planche such that the cutting edge may be replaced when it is worn out. Regarding claims 6 and 7, it is also considered to have been obvious to have provided Inoue with the groove shape shown by Planche in order to mount replaceable honing strips so that they can be removed and replaced when worn.

10. Claims 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Inoue '449 in view of Kress et al (5494383). Kress et al shows that it is conventional to provide a tool with replaceable machining inserts/plates 1 to replace worn machining regions. Figures 1 and 2 show a groove 9 in the insert, and an appropriate clamp 31 fits into this groove. Given the term "being set" in claim 8 its broadest reasonable interpretation, the manual insertion of the insert into the tool body constitutes "setting" the insert. It is considered to have been obvious to have made the honing strips of Inoue exchangeable as shown by Kress et al in order to replace the machining surface when it is worn, and to have provided the groove/claw as disclosed by Kress et al in order to properly secure the insert.

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11. Claims 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Inoue '449 in view of German 3406035. It is common to provide multiple machining areas on the same tool in order to reduce the time to operate on a workpiece. While Inoue has a single reaming step, figure 1 of German '035 shows that it is common to perform two steps of reaming at once. Note steps 12 and 22, plus guide strips 11, 21. It is considered to have been obvious to have provided Inoue with an additional reaming step diameter in order to reduce the time to machine a particular workpiece.

12. Claims 11-16 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

13. Any inquiry concerning the content of this communication from the examiner should be directed to Daniel Howell, whose telephone number is 571-272-4478. The examiner's office hours are typically about 10 am until 6:30 pm, Monday through Friday. The examiner's supervisor, David Bryant, may be reached at 571-272-4526.

In order to reduce pendency and avoid potential delays, Group 3720 is encouraging FAXing of responses to Office actions directly into the Group at FAX number to 571-273-8300. This practice may be used for filing papers not requiring a fee. It may also be used for filing papers which require a fee by applicants who authorize charges to a USPTO deposit account. Please identify Examiner Daniel Howell of Art Unit 3726 at the top of your cover sheet.

/Daniel W. Howell/

Primary Examiner, Art Unit 3726